



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/748,338	12/30/2003	Alex M. Greenberg	5421-3	8136

27799 7590 05/31/2005

COHEN, PONTANI, LIEBERMAN & PAVANE
551 FIFTH AVENUE
SUITE 1210
NEW YORK, NY 10176

EXAMINER

TALBOT, MICHAEL

ART UNIT	PAPER NUMBER
----------	--------------

3722

DATE MAILED: 05/31/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/748,338

Applicant(s)

GREENBERG, ALEX M.

Examiner

Michael W Talbot

Art Unit

3722

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 December 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-36 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6, 8, 10, 13-17, 19-27 and 29-36 is/are rejected.
- 7) ☒ Claim(s) 7, 9, 11, 12, 18 and 28 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 December 2003 is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>2</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Specification

1. The disclosure is objected to because of the following informalities:

Refer to page 5, line 2, the word "threadeldy" has been misspelled and should be changed to --threadedly--.

Refer to page 8, line 18, the character reference "inner threaded area 34" should be changed to --inner threaded area 36--.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 19-24 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

It is unclear how the claimed limitations of claims 19-24 can be dependent upon the claimed limitation of claim 1. As best understood, the claimed limitations of claims 19-24 are best represented by Figure 6. As best understood, the claimed limitations of claim 1 are best represented by Figure 1. Briefly, claim 1 defines a first and second sleeve, where the second sleeve has a defining shoulder (38) to limit the depth penetration. Claims 19-24 depend on claim 1 (based upon claim structure) and shows an alternate means for limiting the depth penetration through the use of the frustoconical member (116) and centering sleeve member (108). It is unclear as to how the two depth penetration methods will be cohesively functional

Art Unit: 3722

when integrated, as suggested by the claim dependency of claims 19-24 on claim 1. It is the examiners best understanding that the claim dependency may have been incorrect, i.e. claim 19 was not intended to depend from claim 1 but rather be shown as an independent claim. If not, the claim language must be rewritten to properly and clearly claim the limitations and/or dependencies of claims 19-24.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3,13,14,16,17,25,31,32,35 and 36 are rejected under 35 U.S.C. 102(b) as being anticipated by Bashlow et al. '353. Bashlow et al. '353 shows in Figures 1-4 a stop (14) for a drill bit (12) where the drill bit has a cutting groove, an elongate body rotatable about an axis, a tip at one end of body, an opposing second end (10) for coupling to a drill and a engagement region disposed between the tip and second end. Bashlow et al. '353 further shows the stop comprising a first sleeve (22,56) being rotatably mounted to drill bit (through connection at 16 and 20) having a first thread (18) and a second thread (38) with a different thread pitch (col. 4, lines 6-28). Bashlow et al. '353 further shows the stop comprising a second sleeve (42) being threadably coupled (44) to second thread of first sleeve and defining a shoulder (54) for limiting a depth of penetration of drill bit into an object (W). Both first and second sleeves have an axis of rotation which is co-incident with axis of drill bit and the first sleeve includes an outwardly projection (56) having a knurled surface (col. 3, lines 57 and 58) providing means for gripping. Bashlow et al. '353 further shows the second thread (38) of the

Art Unit: 3722

first sleeve being disposed on the interior of first sleeve and thread (44) of the second sleeve being disposed on the exterior of second sleeve forming a locking mechanism (34,38,44) between the first and second sleeves. For claims 31,32,35 and 36, both first and second sleeves are considered as a single sleeve member.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 31 and 32 are rejected under 35 U.S.C. 102(e) as being anticipated by Turri '872. Turri '872 shows in Figures 1-4 a stop (20,25) for a drill bit (10) where the drill bit has an elongate body rotatable about an axis, a tip (13) at one end of body, an opposing second end (12) for coupling to a drill and a engagement region (D) disposed between the tip and second ends. Turri '872 further shows the stop (20,25) comprising a sleeve (20,25) having an inner thread (24) rotatably mounted to engagement region on drill bit and the sleeve having an axis of rotation which is co-incident with axis of drill bit.

Claims 1-3,5,6,8,10,15,25-27,29,31,32 and 34 are rejected under 35 U.S.C. 102(e) as being anticipated by Mawhinney '971. Mawhinney '971 shows in Figure 1 a stop (20) for a drill bit (41) where the drill bit has a cutting groove, an elongate body rotatable about an axis, a tip at one end of body, an opposing second end for coupling to a drill and a engagement region disposed between the tip and second end. Mawhinney '971 further shows the stop comprising a first sleeve (54,42,52) being rotatably mounted to drill bit (through connection at 31 and 32) having a first thread (45) and a second thread (threaded area between 42 and 70) with a different thread pitch (seen from details of Figure). Mawhinney '971 further shows the stop comprising a second sleeve (66,62,60) being threadably coupled (threaded area between 42 and 70) to second thread of first sleeve and defining a shoulder (col. 3, lines 43-47) for limiting a

Art Unit: 3722

depth of penetration of drill bit into an object. Both first and second sleeves have an axis of rotation which is co-incident with axis of drill bit. Mawhinney '971 further shows indicia (col. 3, lines 50-52) for both fine and coarse adjustment representing the depth of penetration. Mawhinney '971 further shows the second thread (threaded area between 42 and 70) of the first sleeve being disposed on the exterior of first sleeve and thread (threaded area between 42 and 70) of the second sleeve being disposed on the interior of second sleeve. For claims 31,32,35 and 36, both first and second sleeves are considered as a single sleeve member.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 4,30 and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bashlow et al. '353 in view of Robertson '436. Bashlow et al. '353 lacks the engagement region being both a cutting groove and also an engagement threading of the drill bit. Robertson '436 shows in Figure 5 the stop (26) being directly threaded to the drill bit (28) using the cutting grooves (col. 5, line 65 through col. 6, line 8). In view of this teaching of Robertson '436, it would have been obvious to replace the outwardly directed flange (20) and external threads (18) of the chuck (16) of Bashlow et al. '353 with a direct connection of the stop to the drill bit shown by Robertson '436 to eliminate the need for a specialized chuck.

Allowable Subject Matter

5. Claims 7,9,11,12,18 and 28 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Art Unit: 3722

6. Claim 19-24 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, 1st paragraph, set forth in this Office action.

7. Any inquiry concerning the content of this communication from the examiner should be directed to Michael W. Talbot, whose telephone number is 571-272-4481. The examiner's office hours are typically 8:30am until 5:00pm, Monday through Friday. The examiner's supervisor, Mr. Derris H. Banks, may be reached at 571-272-4419.

In order to reduce pendency and avoid potential delays, group 3720 is encouraging FAXing of responses to Office Actions directly into the Group at FAX number 703-872-9306. This practice may be used for filling papers not requiring a fee. It may also be used for filing papers, which require a fee, by applicants who authorize charges to a USPTO deposit account. Please identify Examiner Michael W. Talbot of Art Unit 3722 at the top of your cover sheet.



Michael W. Talbot
Examiner
Art Unit 3722



DERRIS H. BANKS
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3700